REMARKS

This response, along with the Request for Continued Examination which it accompanies, are intended as a full and complete response to the final Office Action mailed January 11, 2005, and to the Advisory Action mailed on March 21, 2005. In the Office Action, the Examiner notes that claims 1, 2, 4-13 and 15-57 are pending and rejected. By this response, Applicants have amended claims 1, 4, 5, 11, 23, 31, 41 and 49. The amendments to claims 4 and 5 are to correct the dependency of these claims in light of the previous cancellation of claim 3. The amendments to claim 49 are to correct a typographical error. The other amendments to claims are fully supported by the Specification of the present application, for example at least at pages 29-31 and 33-36. Thus, no new matter has been introduced, and the Examiner is respectfully requested to enter the amendments to the claims.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103.

It is to be understood that the Applicants, by making the above amendments, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

Amendments to the Specification

The Specification has been amended on page 1 to clarify that Application Number 08/160,194 is now Patent Number 5,990,927.

Objections

The Examiner has objected to claims 1, 4, 5, 11 and 23 because of various typographical errors. In response, the Applicants have either amended the claims as suggested by the Examiner, or removed the objected-to claim language. Similar typographical errors were also found in claim 31. Accordingly, claim 31 has also been amended. In view of the Applicants' amendment of claims 1, 4, 5, 11 and 23, the

Applicants respectfully request that the Examiner's objections claim objections be withdrawn.

Rejections

35 U.S.C. §103

Claims 1, 2, 3, 4, 6-13, 15-36, 38-44 and 47-56

The Examiner has rejected claims 1, 2, 3, 4, 6-13, 15-36, 38-44 and 47-56 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin (hereinafter "Florin") in view of U.S. Patent 5,483,277 to Granger (hereinafter "Granger"). The Applicants respectfully traverse the rejection.

Applicants' independent claim 1 recites:

> "1. A hardware upgrade for a set top terminal for use with a television program delivery system with menu selection of programs, the set top terminal having a microprocessor and microprocessor instructions for prompting generation of menus, the hardware upgrade comprising:
> an interface to the set top terminal for receiving and processing subscriber input, the set top terminal receiving television program signals based on the subscriber input;
> a disc storage device connected to the interface providing local storage capacity; and
> a microprocessor capable of communicating with the microprocessor of the set top terminal through the interface."

The Florin and Granger references are not prior art for Claim 1

The present application is, inter alia, a divisional of U.S. Patent Application No. 07/991,074 (the '074 Application), filed December 9, 1992. The limitations of claim 1, as amended, are fully supported by the disclosure of the '074 Application, and thus have a priority date of December 9, 1992. For example, the elements of the preamble of claim 1 can be found starting in the summary section of the '074 Application which begins on page 4. Specifically, the television program delivery system and menu selection of programs are disclosed on page 4. The set top terminal is disclosed on page 5. Further description of the basic elements of the set top terminal begin on page 48, for example, the microprocessor and the microprocessor programming instructions of the set top terminal are disclosed on page 49. The elements of the hardware upgrade can, generally speaking, be found at least on pages 54-58 of the specification.

For example, the interface can be found described in the first paragraph on page 54. The disc storage device can be found in the paragraph beginning approximately in the middle of the page 55. The upgrade microprocessor, capable of communicating with the microprocessor of the set top terminal, can be found described in the first paragraph on page 57 and also at the bottom of page 57. Thus, all of the limitations of claim 1 can be found disclosed in the parent '074 application.

Therefore, neither the Florin reference, filed June 22, 1993, nor the Granger reference, filed December 15, 1992, are prior art against claim 1, because these references have priority dates after the priority date of claim 1. As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 11, 23, 31 and 42 have relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claims 11, 23, 31 and 42 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2, 3, 4, 6-10, 12-13, 15-30, 32-36, 38-41, 43 and 47-56 depend, either directly or indirectly, from independent claims 1, 11, 23, 31 and 42 and recite additional limitations thereof. As such, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

The Florin and Granger references do not anticipate or make obvious Claim 1

For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

By alleging that the Applicants' invention is taught by a combination of Granger and Florin, the Examiner is clearly using hindsight to pick and choose elements from the references to support his rejection. There is no justification for combining Granger and Florin in a manner that obviates the claimed invention.

Florin discloses an interactive audio-visual transceiver which is coupled to various entities, such as a television and/or telephone cable, a TV, a VCR, or other devices. In one embodiment, the transceiver has modules such as a CPU, a system bus, and an optional CD ROM. However, as the Examiner acknowledges on page 3 of the present office action "Florin is silent regarding the use of a hardware upgrade".

By contrast, Granger discloses a set-top converter, which in one embodiment may comprise a plug-in module having a tuner. Granger further discloses that "an object of the present invention is to provide a simplified set-top converter for a broadband switched video network." (Column 4, Lines 16-18) Granger also discloses that the benefits of his invention include a set-top converter that is less expensive, less bulky and having simplified circuitry.

The Examiner has not considered either Florin or Granger as a whole, because there is no motivation to combine the audio-visual transceiver of Florin with the tuner module of Granger. The tuner module of Granger is directed towards simplifying the set-top converter of Granger, and also towards cost reduction. There is no teaching in Granger to provide a module which is attachable to a set top converter for the purpose of upgrading the set top converter. Furthermore, there is no teaching in Granger to incorporate a disc storage device in a module which is attachable to a set top converter for the purpose of upgrading the set top converter to allow the use of interactive multimedia applications. Therefore, since Florin does not disclose or suggest hardware upgrades, and Granger does not suggest an attachable module for the purpose of upgrading or having a disc storage device, there is no motivation to combine Florin and Granger in a manner that would yield the claimed invention.

Moreover, even if the combination of the references was desirable, which it is not, the combination of Florin and Granger does not teach or suggest the claimed invention as a whole. The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is

whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

The Florin and the Granger references, alone or in any operable combination, do not teach a hardware upgrade having "a microprocessor capable of communicating with the microprocessor of the set top terminal through the interface" as recited in claim 1 as amended. As the Examiner acknowledges, Florin does not teach a hardware upgrade, and thus could not teach a microprocessor of an upgrade capable of communicating with a microprocessor of a set top terminal through an interface of the upgrade. Granger also does not disclose a microprocessor of an upgrade capable of communicating with a microprocessor of a set top terminal through an interface of the upgrade, as the tuner module of Granger has no microprocessor.

The Examiner has thus failed to establish a prima facie case because there is no motivation to combine the Florin and Granger references in a manner to teach, show or suggest having a hardware upgrade as recited in claim 1, and because the Florin and Granger references fail to teach the invention of claim 1 as a whole.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfy the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 11, 23, 31 and 42 have relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claims 11, 23, 31 and 42 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2, 3, 4, 6-10, 12-13, 15-30, 32-36, 38-41, 43 and 47-56 depend, either directly or indirectly, from independent claims 1, 11, 23, 31 and 42 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Claims 5, 37, 45, 46 and 57

The Examiner has rejected claims 5, 37, 45, 46 and 57 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger in further view of U.S. Patent 5,638,426 to Lewis (hereinafter "Lewis") and U.S. Patent 5,247,575 to Sprague (hereinafter "Sprague"). The Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to independent claim 1. Furthermore, for at least the reasons discussed above, the Applicants submit that there is no motivation to combine Florin with Granger in a manner that obviates the claimed invention of independent claim 1. Moreover, Applicants submit that Florin and Granger, alone or in any operable combination, do not disclose the Applicants' invention of independent claim 1 as a whole.

Lewis does not bridge the substantial gap between the Florin and Granger references and the Applicants' invention of claim 1. Lewis discloses a multimedia system which includes media sub-systems and compression and transmission algorithms. However, Lewis also does not teach or suggest a hardware upgrade for a set top terminal, the upgrade comprising a disc storage device and a microprocessor capable of communicating with a microprocessor of the set top terminal. Furthermore, Lewis also does not provide motivation to combine any of Florin, Granger and Lewis in a manner that would obviate the claimed invention.

Sprague does not bridge the substantial gap between the Florin, Granger and Lewis references and the Applicants' claimed invention. Sprague discloses an information distribution system that provides information to the user and charges the user only for the information provided. However, Sprague also does not teach or suggest a hardware upgrade for a set top terminal, the upgrade comprising a disc storage device and a microprocessor capable of communicating with a microprocessor of the set top terminal. Furthermore, Sprague also does not provide motivation to combine any of Florin, Granger, Lewis and Sprague in a manner that would obviate the claimed invention.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfy the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover,

independent claims 31 and 42 have relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claims 31 and 42 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 5, 37, 45, 46 and 57 depend, either directly or indirectly, from independent claims 1, 31 and 42 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

Official Notices

The Office Action takes numerous official notices. See, for example, pages 6 and 7. Applicant hereby traverses each official notice. For example, the Examiner has taken official notice that the use of an expansion card connector and slot is allegedly well known in the art. The Applicant disagrees. The Examiner has given as an example an expansion card in a PC. However, this is not the same as an expansion card in a set top terminal. The use of an expansion card connector and slot may not be well known in the art of set top terminals or hardware upgrades for set top terminals. The Examiner has also taken official notice that the use of an HDTV enabled terminal is allegedly well known in the art. The Applicants disagree, as, for example, such a terminal may not be well known with respect to the incorporation of a hardware upgrade therein. The Examiner also takes official notice that the use of a SCSI daisy chain arrangement is allegedly well known in the art. The Applicant disagrees, as, for example, such a SCSI daisy chain may not be well known in the art of hardware upgrades for a set top terminal. The Examiner provides only a general description of the benefits of a SCSI daisy chain arrangement, and no discussion regarding the applicability of such an arrangement to a hardware upgrade for a set top terminal.

CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 4/11/05

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